

MAR 30 2004

Atty Docket No. 015280-397100US

PTO FAX NO.: (703) 872-9306

ATTENTION: Examiner Maher M. Haddad
TELEPHONE NO.:

Group Art Unit 1644

**OFFICIAL COMMUNICATION
FOR THE PERSONAL ATTENTION OF
EXAMINER Maher M. Haddad**

CERTIFICATION OF FACSIMILE TRANSMISSION


I hereby certify that the following document(s) in re Application of ROBERTS and KRUTZSCH, Application No. 10/030,735, filed January 9, 2002 for PEPTIDES AND THEIR UTILITY IN MODULATION OF BEHAVIOR OF CELLS EXPRESSING A3B1 INTEGRINS is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Response to Restriction Requirement;
2. Petition for Extension of Time Under 37 CFR 1.136(a);
3. Fee Transmittal Form

Number of pages being transmitted, including this page: 8

Dated: March 30, 2004


Pamela Skelton

**PLEASE CONFIRM RECEIPT OF THIS PAPER BY
RETURN FACSIMILE AT (415) 576-0300**

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Telephone: 858-350-6100
Fax: (858) 350-6111
60178641 v1

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 55.00

Complete If Known

Application Number 10/030,735
 Filing Date January 9, 2002
 First Named Inventor David D. Roberts, et al.
 Examiner Name Maher M. Haddad
 Art Unit 1644
 Attorney Docket No. 015280-397100US

PTO/SB/17 (10-03)

 RECEIVED
 CENTRAL FAX CENTER

MAR 30 2004

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 20-1430

Deposit Account Name Townsend and Townsend and Crew LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	2001	770	385	Utility filing fee	
1002	2002	340	170	Design filing fee	
1003	2003	530	265	Plant filing fee	
1004	2004	770	385	Reissue filing fee	
1005	2005	160	80	Provisional filing fee	
SUBTOTAL (1)					\$5.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims			
Multiple Dependent			

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1202	2202	18	9	Claims in excess of 20	
1201	2201	88	43	Independent claims in excess of 3	
1203	2203	290	145	Multiple dependent claim, if not paid	
1204	2204	88	43	Reissue independent claims over original patent	
1205	2205	18	9	Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					\$

*or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	2051	130	65	Surcharge - late filing fee or oath	
1052	2052	60	25	Surcharge - late provisional filing fee or cover sheet	
1053	1053	130	130	Non-English specification	
1812	1812	2,520	2,520	For filing a request for reexamination	
1804	1804	920*	920*	Requesting publication of SIR prior to Examiner action	
1805	1805	1,840*	1,840*	Requesting publication of SIR after Examiner action	
1251	2251	110	55	Extension for reply within first month	55.00
1252	2252	420	210	Extension for reply within second month	
1253	2253	950	475	Extension for reply within third month	
1254	2254	1,480	740	Extension for reply within fourth month	
1255	2255	2,010	1,005	Extension for reply within fifth month	
1401	2401	330	165	Notice of Appeal	
1402	2402	330	165	Filing a brief in support of an appeal	
1403	2403	290	145	Request for oral hearing	
1451	1451	1,510	1,510	Petition to institute a public use proceeding	
1452	2452	110	55	Petition to revive - unavoidable	
1453	2453	1,330	665	Petition to revive - unintentional	
1501	2501	1,330	665	Utility issue fee (or release)	
1502	2502	480	240	Design issue fee	
1503	2503	640	320	Plant issue fee	
1460	1460	130	130	Petitions to the Commissioner	
1807	1807	50	50	Petitions related to provisional applications	
1806	1806	180	180	Submission of Information Disclosure Sheet	
8021	8021	40	40	Recording each patent assignment per property (times number of properties)	
1809	2809	770	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	2810	770	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	2801	770	385	Request for Continued Examination (RCE)	
1802	1802	900	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid SUBTOTAL (3) (\$55.00)

SUBMITTED BY

Name (Print/Type)	Registration No. (Attorney/Agent)	Telephone
Kawai Lau	44,461	858-350-6100
Signature		Date
		March 30, 2004

Complete (if applicable)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2638.

60178660 v1

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. :1-703-872-9306 on March 30, 2004

TOWNSEND and TOWNSEND and CREW LLP

By: 
Pamela Skelton

PATENT

Attorney Docket No. 015280-397100US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

David D. ROBERTS, et al.

Application No.: 10/030,735

Filed: January 9, 2002

For: PEPTIDES AND THEIR UTILITY IN
MODULATION OF BEHAVIOR OF
CELLS EXPRESSING $\alpha\beta 1$
INTEGRINS

Examiner: Maher M. Haddad

Art Unit: 1644

RESPONSE TO RESTRICTION
REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir;

This is in reply to a Restriction Requirement mailed 30 January 2004, which set 29 February 2004 as the initial deadline for response. Accordingly, a Petition for a one month extension of time until 30 March 2004 is included herewith. This Response is thus believed to be timely filed.

Claims 1-45 are pending and have been restricted. Reconsideration in light of the following amendments and remarks is respectfully requested.

Attorney Docket No. 015280-397100US
Application No.: 10/030,735
Page 2

PATENT

As an initial matter, Applicants point out that independent claim 37 as well as dependent claims 40, 41, and 42 are not accounted for in the Restriction Requirement as presented. Applicants are thus unsure as to the status of these claims relative to the Restriction Requirement and respectfully request clarification on this issue.

The Restriction Requirement sets forth the following Groups:

Group I, claims 1-10 and 13-14;
Group II, claims 11-12 and 17;
Group III, claims 15-16;
Group IV, claim 18;
Group V, claims 19;
Group VI, claims 20-25;
Group VII, claims 26-28;
Group VIII, claim 29;
Group IX, claim 30;
Group X, claims 31-33;
Group XI, claims 31 and 33-36;
Group XII, claims 38, 39 and 43;
Group XIII, claims 38, 39 and 43;
Group XIV, claims 38, 39 and 43;
Group XV, claims 38, 39 and 43;
Group XVI, claims 38, 39 and 43; and
Group XVII, claims 43-45.

Furthermore, and on page 4, paragraph 6 of the Restriction Requirement, two requirements for an election of species were presented. With respect to Groups I to XVII, a requirement to elect a species based upon a specific peptide sequence was set forth. With respect to Groups XI to XVI, a requirement to elect an animal was set forth.

The basis for the Restriction Requirement under 35 U.S.C. §§ 121 and 372 is that the inventions of claims 1, 2, 6-9, 13 and 17 allegedly do not present a contribution over the cited

Attorney Docket No. 015280-397100US
Application No.: 10/030,735
Page 3

PATENT

document by Miles et al. Applicants disagree that Miles et al. constitutes "prior art" as alleged in the Restriction Requirement. Miles et al. is alleged to disclose peptides comprising the sequence DLRL such that the invention of claims 1, 2, 6-9, 13 and 17 do not constitute a special technical feature. The Restriction Requirement thus asserts that the claims lack unity of invention. Applicants respectfully point out that no allegation of lack of unity between claims 1, 2, 6-9, 13 and 17, as a group, and independent claims 11, 14, 15, 20, 26, 29, 30, 37 and 44 has been made.

Without acquiescence to the allegations based on Miles et al., and in the interest of being fully responsive to the Restriction Requirement, Applicants hereby begin by election, with traverse, of a specific peptide sequence of NVRFVF corresponding to positions of X_1 - X_2 - X_3 - X_4 - R_2 of the peptide sequence formulas set forth in the claims (where NVRF corresponds to X_1 - X_2 - X_3 - X_4 and VF corresponds to R_2). Peptides with this sequence are fully within the scope of the pending claims, and a non-limiting example of a larger peptide comprising this sequence is seen in SEQ ID NO:26. This election is believed to be fully responsive to the requirement for a species election as set forth on page 4 of the Restriction Requirement.

Applicants understand that the requirement for the election of a single species is to facilitate search and examination. If no prior art is found to anticipate or render obvious the elected species, Applicants understand that the search of the claims will be extended to the next species.

With the above election, Applicants respectfully traverse the alleged lack of unity based upon Miles et al., which does not disclose peptides comprising the sequence NVRFVF. Peptides comprising this elected sequence now constitute a special technical feature that provide unity of invention to all claims encompassing such peptides. Applicants believe this to include all the claims of Groups I to XVII. Accordingly, Applicants respectfully request withdrawal of the Restriction Requirement between these Groups in light of the above election.

In the event that the Restriction Requirement is maintained despite the above, Applicants respectfully traverse the restriction of Group I from each of Groups II and III because Group I is related to each as a subcombination to a combination. No basis for restriction according to the standards for combination/subcombination has been presented, and so the

Attorney Docket No. 015280-397100US
Application No.: 10/030,735
Page 4

PATENT

restriction between these Groups should be withdrawn. The restriction between Group II and each of Groups IV and V, which are also related as subcombination to combination should also be withdrawn.

With respect to Groups VI to IX and XI to XVII, each is essentially a method for the use of a peptide according to at least Group I and so is potentially subject to rejoinder according to the standards set forth at MPEP 821.04. Similarly, Group X is a method for the use of the invention of Group II.

With respect to Groups XII to XVI, inclusive, Applicants respectfully traverse because the restriction appears to ignore the fact that claim 37 is a linking claim that links the inventions of claims 38-43. The Examiner's attention is directed to MPEP 809.03, which details the handling of linking claims. Applicants believe that the division of the claims based upon the disease to be treated (as asserted in the Restriction Requirement) is an assertion of each disease as representing different species.

If the proper existence and status of the linking claims is not recognized, the Examiner will have the ability to denied examination of claims which the Applicants regard as their invention. See *In re Weber* (580 F.2d 455, 198 USPQ 328 (CCPA 1978)) and *In re Haas* (580 F.2d 461, 198 USPQ 334 (CCPA 1978)), and the discussion at MPEP 803.02 in an analogous context. These cases clearly set forth that a restriction requirement cannot be used to divide a single claim, such as a linking claim.

Applicants respectfully traverse for the reasons provided above and request that the Restriction Requirement be withdrawn or at least modified wherein the claims of Group I and at least one of Groups II and III are recombined; the claims of Group II are recombined with at least one of Groups IV and V; and the claims of Groups XII to XVI are recombined.

In the event that the Restriction Requirement is maintained, Applicants elect Group I, claims 1-10 and 13-14, with traverse for the reasons provided above. This election is in combination with the sequence election, with traverse, as stated above.


Applicants reserve the right to pursue the subject matter of any non-elected claim in a subsequent divisional or other continuing application without prejudice.

Attorney Docket No. 015280-397100US
Application No.: 10/030,735
Page 5

PATENT

If the Examiner believes a telephonic discussion would expedite prosecution of this application, she/he is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,


Kawai Lau, Ph.D.
Reg. No. 44,461

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
(858) 350-6151
Fax (415) 576-0300
KL/ps

rev. 10/03
60144687 v1